

### **Remarks**

Claims 1, 23, 42-45 are pending in the application. No claims were amended or canceled. Furthermore, the Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

### **Claim Rejections Based on the Judicially-Created Doctrine of Obviousness-Type Double Patenting**

Claims 1, 23, 42-45 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of U.S. Patent No. 6,323,339 ("the '339 patent"). Therefore, to expedite prosecution to allowance of the pending claims, the Applicants submit herewith a Terminal Disclaimer, corresponding to the patent cited by the Examiner. The Disclaimer is accompanied by the appropriate fee, and the Applicants believe that it complies with the requirements of 37 CFR 1.321(c).

Accordingly, withdrawal of the rejections under the judicially-created doctrine of obviousness-type double patenting is respectfully requested.

### **Claim Rejections Based on 35 USC § 103(a)**

Claims 1, 23 and 42-45 stand rejected under 35 USC § 103(a), based on the Examiner's contention that they are unpatentable over U.S. Patent 6,323,339 ("the '339 patent") in view of Sabesan (U.S. Patent 5,095,123). The Applicants respectfully disagree.

The Applicants respectfully assert that the '339 patent is not available as prior art under 35 USC § 103(a) because the present application is a CON of U.S. Patent Application No. 09/413,381, which matured into the '339 patent. Consequently, the '339 patent cannot be applied as prior art against the present application.

The Examiner comments that the compounds disclosed in reaction scheme 1 and examples 2, 3, and 5 of U.S. Patent 5,095,123 fall within the scope of instant claims 1 and 23.

The Applicants respectfully remind the Examiner that the compounds in reaction scheme 1 and examples 2, 3, and 5 of U.S. Patent 5,095,123 are diphenyl phosphates, which compounds do not fall within the scope of instant claims 1 and 23. Please see the previous Office Communication response dated June 6, 2003 for a discussion of the fact that the diphenyl phosphates disclosed in U.S. Patent 5,095,123 do not fall within the scope of the amended claims. Therefore, U.S. Patent 5,095,123 alone cannot establish a *prima facie* case of obviousness of the rejected claims. In this regard, the Applicants respectfully remind the Examiner that in order "to establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *MPEP* 2143.03. *See also In re Royka*, 490 F.2d 981.

Accordingly, the Applicants respectfully request the withdrawal of the rejection of claim 1 under 35 USC § 103(a).

#### *Fees*

The Applicants believe they have provided for the required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account, **06-1448**.

**Conclusion**

In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. The Applicants respectfully request reconsideration and withdrawal of the pending rejections. The Applicants thank the Examiner for careful consideration of the present case. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned.

Respectfully submitted,  
FOLEY HOAG LLP



Dana M. Gordon, Ph.D.  
Registration No. 44,719  
Attorney for Applicants

Patent Group  
FOLEY HOAG LLP  
155 Seaport Boulevard  
Boston, MA 02210

(617) 832-1000  
(617) 832-7000 (FAX)

Date: \_\_\_\_\_

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